

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Michael Schütz et al.

Serial No.: 10/519,259

Filed: February 14, 2006

For: METHOD FOR DETECTING AND FOR
REMOVING ENDOTOXIN

Patent No.: 7,585,620

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**CERTIFICATE OF ELECTRONIC TRANSMISSION
37 C.F.R. § 1.8**

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Trademark Office via EFS-Web on the date below:

October 19, 2009
Date

Steven L. Highlander

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicants request reconsideration of Patent Term Adjustment (PTA) under 37 C.F.R. §1.705(d). The Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) included with the Issue Notification dated August 19, 2009 indicates a PTA of 0 days. Applicants believe this to be an error and request the PTA to be changed to 81 days.

REMARKS

Applicants respectfully submit that the United States Patent and Trademark Office (PTO) did not apply the proper standard for determining the period of delay under 35 U.S.C. § 154(b)(1)(B). It is Applicants' understanding that for purposes of calculating this delay, the PTO measured application pendency as beginning on December 31, 2003, the date on which the application fulfilled the requirements of 35 U.S.C. § 371. However, as detailed below, the relevant statutes and regulations require that when calculating this delay for a national stage filing under 35 U.S.C. § 371, application pendency must be measured from the date that is 30 months from the priority date of the international application, not from the date on which the application fulfilled the requirements of 35 U.S.C. § 371.

The term of a patent shall, under certain circumstances, be extended if the Office fails to issue a patent within three years after the "actual filing date" of the application.

(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY – Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States ... the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued. 35 U.S.C. § 154(b)(1)(B). (emphasis added)

37 C.F.R. § 1.702(b) explains the meaning of the term "actual filing date" as used in 35 U.S.C. § 154(b)(1)(B). As detailed below, PTO delay for a national stage application begins if the PTO fails to issue a patent within three years after the date the national stage "commenced under 35 U.S.C. 371(b) or (f)."

(b) *Failure to issue a patent within three years of the actual filing date of the application.* Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under

35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, but not including: (1) Any time consumed by continued examination of the application under 35 U.S.C. 132(b)... 37 C.F.R. § 1.702(b). (emphasis added)

35 U.S.C. §§ 371(b) and (f) refer to the time when a national stage application “commences.”

(b) Subject to subsection (f) of this section, the national stage shall commence with the expiration of the applicable time limit under article 22 (1) or (2), or under article (1)(a) of the treaty. 35 U.S.C. § 371(b). (emphasis added)

(f) At the express request of the applicant, the national stage of processing may be commenced at any time at which the application is in order for such purpose and the applicable requirements of subsection (c) of this section have been complied with. 35 U.S.C. § 371 (f).

35 U.S.C. § 371(f) relates to the situation where an applicant files an express request for early processing of an international application. In the absence of filing such a request, the U.S. national stage commences under the provisions of 35 U.S.C. § 371(b), i.e., with the expiration of the applicable time limit under article 22(1) or (2), or under article 39(1)(a) of the treaty. The term “the treaty” refers to “the Patent Cooperation Treaty done at Washington, on June 19, 1970.” See 35 U.S.C. § 351(a).

The articles of the Patent Cooperation Treaty cited in 35 U.S.C. § 371(b) are reproduced below.

Article 22

Copy, Translation, and Fee, to Designated Offices

(1) The applicant shall furnish a copy of the international application (unless the communication provided for in Article 20 has already taken place) and a translation thereof (as prescribed), and pay the national fee (if any), to each designated Office not later than at the expiration of 30 months from the priority date. Where the national law of the designated State requires the indication of the name of and other prescribed data concerning the inventor but allows that these indications be furnished at a time later than that of the filing of a national application, the applicant

shall, unless they were contained in the request, furnish the said indications to the national Office of or acting for the State not later than at the expiration of 30 months from the priority date. (emphasis added)

(2) Where the International Searching Authority makes a declaration, under Article 17(2)(a), that no international search report will be established, the time limit for performing the acts referred to in paragraph (1) of this Article shall be the same as that provided for in paragraph (1).

Article 39

Copy, Translation, and Fee, to Elected Offices

(1) (a) If the election of any Contracting State has been effected prior to the expiration of the 19th month from the priority date, the provisions of Article 22 shall not apply to such State and the applicant shall furnish a copy of the international application (unless the communication under Article 20 has already taken place) and a translation thereof (as prescribed), and pay the national fee (if any), to each elected Office not later than at the expiration of 30 months from the priority date. (emphasis added)

“The applicable time limit” referred to in Patent Cooperation Treaty articles 22(1), 22(2), and 39(1)(a) is “the expiration of 30 months from the priority date.” As a result, “the expiration of 30 months from the priority date” is the time at which the U.S. national stage commences under the provisions of 35 U.S.C. § 371(b). This same conclusion as to the timing for commencement of the U.S. national stage is also summarized in MPEP § 1893.01.

Subject to 35 U.S.C. 371(f), commencement of the national stage occurs upon expiration of the applicable time limit under PCT Article 22(1) or (2), or under PCT Article 39(1)(a). See 35 U.S.C. 371(b) and 37 CFR 1.491(a). PCT Articles 22(1), 22(2), and 39(1a) provide for a time limit of not later than the expiration of 30 months from the priority date. Thus, in the absence of an express request for early processing of an international application under 35 U.S.C. 371(f) and compliance with the conditions provided therein, the U.S. national stage will commence upon expiration of 30 months from the priority date of the international application.

Pursuant to 35 U.S.C. 371(f), the national stage may commence earlier than 30 months from the priority date, provided applicant makes an express request for early processing and has complied with the applicable requirements under 35 U.S.C. 371(c). MPEP § 1893.01. (emphasis added)

In view of the foregoing, the “actual filing date” of a U.S. national stage application filed under 35 U.S.C. § 371, for purposes of calculating delay under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.702(b), is the date that is 30 months from the priority date of the international application.

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

The present application is a national stage filing under 35 U.S.C. § 371 of international application number PCT/DE03/02096, filed June 24, 2003, which claims the benefit of priority of German application number DE 102 28 133, filed June 24, 2002 and German application number DE 103 07 793, filed February 24, 2003.

The national stage for the present application “commenced” under the provisions of 35 U.S.C. § 371(b), i.e., upon expiration 30 months from the priority date of the international application. As a result, the date that the national stage commenced was December 24, 2004 (i.e., 30 months from the priority date of June 24, 2002).

The period beginning on December 25, 2007 (the day after the date that is three years after December 24, 2004, the date that the national stage commenced), and ending June 11, 2008 (the date a Request for Continued Examination was filed), is 170 days in length.

In view of the period of delay detailed above, the total PTO delay for this patent should be calculated as 170 days. The PTO calculated 0 days of PTO delay. Applicants respectfully submit that the PTO’s calculation of this PTO delay is incorrect and that the correct PTO delay for issuance beyond three years from filing is 170 days. See 37 C.F.R. §§ 1.702(b) and 1.703(b).

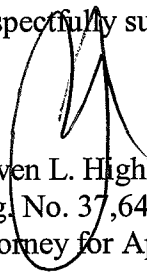
CONCLUSION

In consideration of the events described above, Applicants believe the PTA calculation of 0 days is incorrect. As such, Applicants respectfully request reconsideration of the PTA in the following manner:

- 1) Total PTO delay should be calculated as 170 days;
- 2) Total Applicant delay should be calculated as 89 days; and
- 3) Total PTA should be calculated as 81 days.

The required fee in the amount of \$200.00 in connection with the filing of this paper is being charged to a credit card through EFS-Web concurrently with this submission. The Commissioner is hereby authorized to deduct any underpayment of fees or any additional fees required under 37 C.F.R. §§ 1.16 to 1.21 in connection with the filing of this paper from Fulbright & Jaworski Deposit Account No.: 50-1212/DEBE:046US.

Respectfully submitted,


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